

REMARKS

Applicant requests favorable reconsideration and allowance of this application in view of the foregoing amendments and the following remarks.

Claims 1-6 and 8-36 are pending in this application, with Claims 1, 9, 15 and 26 being independent. Claim 7 has been cancelled herein without prejudice.

Claims 1-4 and 8-12 have been amended. Applicant submits that support for the amendments can be found in the original disclosure. For example, the feature of determining whether a document is to be stored in a compressed or non-compressed state is disclosed at least at page 8, line 25 to page 10, line 23. Therefore, Applicant submits that no new matter has been added.

Initially, Applicant notes that Claims 15-34 have neither been examined on the merits nor indicated as being withdrawn from consideration. Applicant submits that those claims should be considered on the merits but, in any event, requests clarification of the status of those claims.

More specifically, in the restriction requirement mailed April 4, 2008, the Examiner indicated that the claims of Group I (Claims 1-14) and those of Group II (Claims 15-36) have separate utility such as image processing in compressed form (Claims 1 and 9) and image storage or retrieval (Claims 15 and 26). In a telephone conversation, the Examiner indicated that if independent Claims 15 and 26 were amended to include the features of generating compressed and non-compressed data, then all of the claims would be considered. Those claims were amended in that manner. In particular, in the Response to Restriction Requirement and Amendment filed on April 17, 2008, Claim 15 was amended so that it currently recites both a compressing step of generating compressed data for a first digital document and an abstract generating step of generating non-compressed abstract data, and Claim 26 was similarly

amended. Accordingly, since Claims 15 and 26 recite generating compressed data and non-compressed data, the Claims 15-34 should have been examined on the merits together with Claims 1-14, 35, and 36, in accordance with the Examiner's comments. Accordingly, Applicant respectfully requests examination of Claims 15-34, or at the very least an explanation as to why those claims are not being examined.

Claim 7 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant submits that this rejection is moot, since Claim 7 has been cancelled.

Claims 1-14, 35 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,539,842 (Schwartz). Applicant respectfully traverses this rejection for the reasons discussed below.

As recited in independent Claim 1, the present invention includes, *inter alia*, (i) a checking step of determining based on a predetermined reference whether each of a plurality of various digital documents is to be stored in a compressed or non-compressed state, wherein the plurality of various digital documents include a first digital document and a second digital document, (ii) a compressing step of generating compressed data for the first digital document when it is determined in the checking step that the first digital document is to be stored in a compressed state, (iii) a non-compressing step of generating non-compressed data for the second digital document when it is determined in the checking step that the second document is to be stored in a non-compressed state, and (iv) a generation step of generating an archive file that stores both the compressed first digital document and the non-compressed second digital document.

As stated in the above-mentioned features of Claim 1, the claimed method determines for each of the plurality of various digital documents is to be stored in a compressed or non-

compressed state. A generating step is performed either way. That is, compressed data is generated for a first digital document when the checking step determines that the first digital document is to be stored in a compressed state, and non-compressed data is generated for a second digital document when the checking step determines that the second document is to be stored in a non-compressed state. An archive file is generated that stores both the compressed first digital document and the non-compressed second digital document.

According to the above features of Claim 1, a file size can be reduced while shortening the processing time required for expansion.

Applicant submits that the cited art fails to disclose or suggest at least the above-mentioned features of Claim 1. Schwartz appears to disclose a determining step for determining whether blocks forming an image should be binary-compressed at a binary compressor 202 or JPEG-compressed at a continuous tone compressor 203. In each case, image blocks are compressed, i.e., Schwartz does not appear to disclose a step of generating non-compressed data when it is determined that a digital document is to be stored in a non-compressed state.

The Examiner cited col. 10, lines 29-32, and Fig. 1, items 102 and 103 as allegedly disclosing the claimed checking step. However, that cited portion discloses no such checking step. In particular, the cited lines merely stated that a compressed binary image is transmitted and/or stored. There is nothing whatsoever regarding a checking step of determining based on a predetermined reference whether each of a plurality of various digital documents is to be stored in a compressed or non-compressed state.

The Examiner cited the description of column 15, lines 15-22 as allegedly disclosing the claimed step of generating non-compressed data. Applicant submits that the cited portion merely shows a binary extractor 1200 and does not disclose or suggest a step of generating non-compressed data for a second digital document *when it is determined in a checking step that the second document is to be stored in a non-compressed state*, as recited in Claim 1.

The Examiner cited the description at column 5, lines 20-23 and Figs. 1 and 12 as allegedly disclosing the claimed step of generating an archive file. Applicant submits that the cited portion merely discloses a system that comprises a digital photocopier, facsimile, document archiving system, or the like that performs compression and decompression. The cited portion does not, however, provide any disclosure of generating an archive file that contains both compressed data for a first digital document and non-compressed data for a second digital document. To the contrary, as indicated by the title, the Schwartz patent is entirely directed to compressing and decompressing images of documents, not to storing a combination of compressed data and non-compressed data.

For the foregoing reasons, Applicant submits that the present invention recited in Claim 1 is patentable over the art of record. Independent Claim 9 is an apparatus claim with features corresponding to Claim 1, and Claim 9 is believed patentable for reasons similar to Claim 1.

The dependent claims are believed patentable for at least the same reasons as the independent claims, as well as for the additional features they recite.

In view of the foregoing, Applicant requests consideration of all claims and an early Notice of Allowance.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicant

Brian L. Klock

Registration No. 36,570

FITZPATRICK, CELLA, HARPER & SCINTO

30 Rockefeller Plaza

New York, New York 10112-3801

Facsimile: (212) 218-2200

BLK/icw

FCHS_WS 2660761_1